

Remarks/Arguments

The present submission under 37 C.F.R. § 1.114 in conjunction with Applicant's Request for Continuing Examination (RCE) is made in response to the final Office Action dated June 19, 2006, and identified as Paper No. 20060604. Claims 4, 6-10, 12-14, 18-21 and 25-27 are pending.

Applicant thanks the Examiner for the courtesy of an interview on August 10, 2006.

Although an agreement was not reached, the Examiner confirmed that the claimed invention recited a concrete and tangible result and clarified that the rejections for lack of utility under 35 U.S.C. § 101 were based on the fact that the claims did not recite the step of displaying or outputting the claimed value in a manner that could be used.

Applicant has therefore amended the independent claims according to the guidance provided by the Examiner to recite the step of “displaying” or “outputting” the concrete and tangible value that is determined by the claimed invention. As recited in the specification at page 10, lines 1-9, the claimed invention may be implemented in a spreadsheet for ease of calculations. As a spreadsheet is “[a]n accounting or bookkeeping program that *displays* data in rows and columns on a screen,” *see* www.dictionary.com or virtually any other available dictionary, the use of a spreadsheet necessarily entails *displaying* or *outputting* the admittedly concrete and tangible value of an intangible asset as determined by the present invention.

The usefulness of the discrete value of an intangible asset that is displayed or output by the present invention is not in dispute. As explained in the specification, the outputted value of an intangible asset may be used to assist in the management of the intangible asset, to plan the development of products incorporating the intangible asset, to negotiate licenses pertaining to the intangible asset, and to select among research investments. *See* Specification, page 1, lines 10-

RCE in Reply to Final Office Action dated June 19, 2006

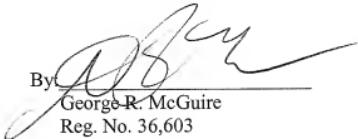
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19 and page 6, lines 1-13. Notably, the use for the claimed invention does not have to be recited in the claim itself, particularly if the specification identifies one or more credible uses for the claimed invention. See MPEP §§ 1701 and 1701.01; *see also* In re Fisher, 421 F.3d 1365 (Fed. Cir. 2005) ("whether an application *discloses* a utility for a claimed invention is a question of fact") (emphasis added).

In view of the foregoing amendments, the Examiner's reconsideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, please contact the undersigned at (315) 218-8515.

Respectfully submitted,


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